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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/522,715	01/28/2005	Karl Haberle	264519US0PCT	7463
22850	7590	08/26/2005	EXAMINER	
OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314			NILAND, PATRICK DENNIS	
			ART UNIT	PAPER NUMBER
			1714	
DATE MAILED: 08/26/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/522,715

Applicant(s)

HABERLE ET AL.

Examiner

Patrick D. Niland

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |  |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)            |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>1/05</u> . | 6) <input type="checkbox"/> Other: ____  |

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1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-2 and 8-15 are rejected under 35 U.S.C. 102(b) as being anticipated by US Pat. No. 5856420 Tucker et al..

Tucker discloses the instantly claimed mixture at column 6, lines 19-31 where the polyether polyols are emulsifiers and will react in accordance with the instant claim 2. The examples of column 9, lines 40-49 all use solvent amounts within the scope of the instant claim 8. Additives are disclosed at column 6, lines 46-48. The coating method of the reference falls within the scope of the instant method claims as this bonds the coating substrate to the substrate being coated and the instantly claimed methods of adhesively bonding substrates requires no additional substrates. Note column 6, lines 47-57.

4. Claims 1-2 and 8-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Pat. No. 5856420 Tucker et al..

Tucker discloses the instantly claimed mixture at column 6, lines 19-31 where the polyether polyols are emulsifiers and will react in accordance with the instant claim 2. The examples of column 9, lines 40-49 all use solvent amounts within the scope of the instant claim 8. Additives

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are disclosed at column 6, lines 46-48. The coating method of the reference falls within the scope of the instant method claims as this bonds the coating substrate to the substrate being coated and the instantly claimed methods of adhesively bonding substrates requires no additional substrates. Note column 6, lines 47-57.

It would have at least been obvious to one of ordinary skill in the art to use the instantly claimed combinations of ingredients because they are encompassed by the patentee and would have been expected to give the coating properties of the patentee.

5. Claims 1-15 are rejected under 35 U.S.C. 102(b) as being anticipated by WO 01/38415 Huynh-ba.

Huynh-ba discloses the instantly claimed compositions and methods at page 2, lines 25-37; page 3, lines 1-38, particularly 15-38, which encompasses the instant claim 8; page 4, lines 1-37, particularly 1-3 and 23-26, which encompasses the instant claim 7; page 13, line 20 to page 15, line 2 of which the polysiloxane polyether of page 14, line 6 falls within the scope of the emulsifier instant claims; and the remainder of the document. The compound of page 16, lines 9-21 falls within the scope of the compound of the instant claims 4-6. Everything in the compositions of the reference fall within the scope of additives of the instant claims 9-10 and 14. The coatings of the reference adhere to one substrate, which is all that is required of the instant claims 11-13 and 15. Where the multiple coatings are applied, as is typical of coating the substrates of the reference, there are "layers".

6. Claims 1-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO 01/38415 Huynh-ba in view of US Pat. No. 5387367 Haeberle et al. and US Pat. No. 6426414 Laas et al..

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Huynh-ba discloses the compositions discussed in paragraph 5 above. It would have been obvious to one of ordinary skill in the art at the time of the instant invention to use the instantly claimed polyethers in the instantly claimed amounts as emulsifiers in the compositions of Huynh-ba because Haeberle and Laas show incorporating such compounds into polyisocyanates is well known for making them more stably dispersible in aqueous systems and placing the composition of Huynh-ba in water would have been expected to give only predictable results such as decreasing EPA regulated and expensive solvent content. Furthermore, where the solvents of Huynh-ba do not dissolve the polymers, emulsifiers having HLBs which are compatible with the solvents used will be known to stabilize such systems. In more hydrophobic systems the HLB of the polyether emulsifiers of Haeberle and Laas can be made more hydrophobic, i.e. polypropylene or polytetramethylene ethers can be used as the emulsifying polyether segment.


7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patrick D. Niland whose telephone number is 571-272-1121. The examiner can normally be reached on Monday to Thursday from 10 to 5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan, can be reached on 571-272-1119. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR

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system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Patrick D. Niland  
Primary Examiner  
Art Unit 1714